Remarks/Arguments

Reconsideration of this application is respectfully requested.

Claims 5-10, 15-18, and 20-24 are pending in the application, with claims 5-9, 15-18, and 20 having been amended, claims 1-4, 11-14, and 19 having been canceled, and new claims 21-24 having been added.

Claims 1 and 11 have been:

(A) provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1 and 3 of co-pending Application No. 10/892,610 (published as 2005/0176594 A1);

(B) provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1 and 12-14 of co-pending Application No. 10/483,342 (published as 2004/0147414 A1);

(C) rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1 and 3 of U.S. Patent No. 6,887,835 B1 (Migdal);

(D) rejected under 35 U.S.C. 103(a) as being obvious over Grabowski (U.S. 2005/0176594 A1 corresponding to Application No. 10/892,610); and

(E) rejected under 35 U.S.C. 103(a) as being obvious over Migdal (U.S. 2005/0147414 A1 corresponding to Application No. 10/483,342).

Claims 1 and 11 have been canceled. Accordingly, it is requested that the above rejections be withdrawn.

Claims 1, 2, 4, 6-8, 11, 12, 14, and 16-18 have been rejected under 35 U.S.C. 102(b) as being anticipated by Reyes-Gavilan et al. (EP 1,054,052 A2; see also U.S. Patent No. 6,410,490).

Claims 5 and 15 have been rejected under 35 U.S.C. 103(a) as being unpatentable over Reyes-Gavilan et al. in view of Oysaed et al. (U.S. 2006/0122295 A1).

Claims 3 and 13 have been rejected under 35 U.S.C. 103(a) as being unpatentable over Reyes-Gavilan in view of Wegmann et al. (WO 2005/023886).

Claims 9, 10, 19, and 20 have been rejected under 35 U.S.C. 103(a) as being unpatentable over Reyes-Gavilan et al. in view of Oysaed et al. and Wegmann et al.

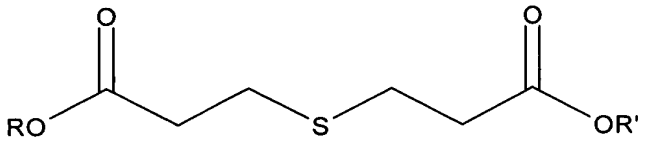
Reyes-Gavilan et al. disclose a lubricant composition stabilized against the deleterious effects of heat and oxygen. The composition comprises a hydrotreated or hydrodewaxed oil and an effective antioxidant stabilizing amount of a mixture of a phenolic antioxidant; an N,N-disubstituted aminomethyl-1,2,4-triazole; an aromatic amine antioxidant; an alkyl phenoxy alkanoic acid; and an N-acyl sarcosine derivative. Optionally, further additives are added to the subject lubricant compositions.

Oysaed et al. disclose an antioxidant composition comprising (a) 0.01-0.5% by weight of sterically hindered phenolic compound, (b) 0.01-0.5% by weight of phosphorous compound, and (c) 0.01-1% by weight of sulphur-containing compound. The antioxidant composition is said to reduce degradation of plastic materials during processing and end-use and thus, increases the long term thermal stability of those plastic materials.

Wegmann et al. disclose a stabilized composition of methylmethacrylate-butadiene graft copolymers with selected sterically hindered phenolic antioxidants and thioethers.

All of the claims currently pending in the application require the presence of a first antioxidant that is butyl-3-(3,5-di-tert-butyl-4-hydroxyphenyl)propionate. However, as has been acknowledged by the Examiner in section 17 of the Office Action (page 14, lines 9-10), Reyes-Gavilan et al. do not specifically disclose their hindered phenolic as butyl-3-(3,5-di-tert-butyl-4-hydroxyphenyl)propionate. Accordingly, it is clear that Reyes-Gavilan et al. do not anticipate the currently claimed invention under 35 U.S.C. 102(b).

Further, there is disclosure in Reyes-Gavilan et al. of a greater than 40% solution of butyl-3-(3,5-di-tert-butyl-4-hydroxyphenyl)propionate in a second antioxidant that is a dialkyldithiopropionate of the structure:



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wherein R and R' are independently selected from the group consisting of straight chain and branched chain alkyl groups, e.g., ~~ditridecyldithioproprionate~~ ditridecyldithiopropionate, as now required by all the claims. Support for this amendment to the claims appears in the specification in the paragraph beginning on page 6 at line 8.

Accordingly, it is requested that the rejection of claims 1, 2, 4, 6-8, 11, 12, 14, and 16-18 under 35 U.S.C. 102(b) as being anticipated by Reyes-Gavilan et al. be withdrawn.

The secondary references, Oysaed et al. and Wegmann et al., fail to supplement these deficiencies of Reyes-Gavilan et al.

Oysaed et al. merely show that di-tridecyl-thio-di-propionate (a.k.a. detridecyldithiopropionate) is known as an antioxidant for plastic polymers, such as polypropylene. There is no disclosure or suggestion that this antioxidant could be used as a solvent for butyl-3-(3,5-di-tert-butyl-4-hydroxyphenyl)propionate to form a liquid concentrate.

Wegmann et al. merely show that esters of (3,5-di-tert-butyl-4-hydroxyphenyl)propionic acid with a mono alcohol can be used as antioxidants for methylmethacrylate-butadiene-styrene graft copolymers. Again, there is no disclosure or suggestion that a dialkyldithiopropionate of the structure of the present claims could be used as a solvent for butyl-3-(3,5-di-tert-butyl-4-hydroxyphenyl)propionate to form a liquid concentrate.

Further, Wegmann et al. teach that, even as between two polymers of very similar structure, e.g., ABS and MBS, interactions with antioxidants can vary unpredictably (see Wegmann et al. beginning on page 1 at line 31 and continuing on to page 2 at line 16). Clearly, if one cannot predict the effectiveness of a given antioxidant for a given polymer, e.g. MBS, in view of its known effectiveness for a different, but very similar polymer, e.g., ABS, it stands to reason that the performance of an antioxidant for a lubricant cannot be predicted on the basis of that antioxidant's performance for a polymer. On the basis of this teaching of Wegmann et al., those skilled in the art would have no motivation to use butyl-3-(3,5-di-tert-butyl-4-hydroxyphenyl)propionate in combination with a dialkyldithiopropionate to arrive at the currently claimed invention.

It is therefore requested that the rejections of:

claims 5 and 15 under 35 U.S.C. 103(a) as being unpatentable over Reyes-Gavilan et al. in view of Oysaed et al.;

claims 3 and 13 under 35 U.S.C. 103(a) as being unpatentable over Reyes-Gavilan in view of Wegmann et al.; and

claims 9, 10, 19, and 20 under 35 U.S.C. 103(a) as being unpatentable over Reyes-Gavilan et al. in view of Oysaed et al. and Wegmann et al. be withdrawn.

In view of the foregoing, it is submitted that this application is in condition for allowance, and an early Office Action to that end is earnestly solicited.

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